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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/827,434

04/20/2004

Ian Carr

0100/0157

2721

21395

7590

07/06/2010

LOUIS WOO

LAW OFFICE OF LOUIS WOO

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ALEXANDRIA, VA 22314

EXAMINER

GRAY, PHILLIP A

ART UNIT

PAPER NUMBER

3767

MAIL DATE

DELIVERY MODE

07/06/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/827,434	<b>Applicant(s)</b> CARR ET AL.	
	<b>Examiner</b> Phillip Gray	<b>Art Unit</b> 3767	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-14, 16-18 and 20 is/are rejected.
- 7) ☒ Claim(s) 15, 19 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This office action is in response to applicant's communication of 4/2/2010.

Currently elected claims 1-3 and 5-21 are pending and rejected below.

Claim 4 has been previously withdrawn; Correction to the claims status to indicate this is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6, 10, 11, 17, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Stevens (U.S. Patent 3,073,307). Stevens discloses a cylindrical body (10) having an opening (near 28), neck (11) with cover (24), weakened joint (near 19), finger grasp means (wing type structure 26), lock mechanism first portion and second portion (at 14) and needle hub assembly (near 13) comprising a base with double ended needle (12) and catch (14) and distal section (hub portion near 19 in cover 24) and notch (near line 3).

Concerning the claim language of the finger grasp means coupled to said cover "at a desired location along the length of said cover to amplify the torque force applied by a user to said cover when the user applies a predetermined torque to said finger grasp means to rotate said cover relative to said body to separate said cover from said

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neck at said weakened joint, said predetermined torque if applied anywhere along the length of said cover whereto said finger grasp means is not coupled would fail to separate from said neck", it is examiners position that Stevens discloses this. Stevens discloses finger grasp means (26) coupled to the cover (24) along a length "at a desired location" (as shown in figures 1-4). It is examiner's position that Steven's finger grasp means would also carry out the as specified in the new amendments to the claim of "amplify the torque" where there are finger grasp means and places where the finger grasp means are not (i.e. top uppermost portion of the cover) would fail to separate the cover from the neck since torque was not properly applied (or "amplified").

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7, 8, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens. Stevens discloses the claimed invention except for the torque required to separate the cover being 60 ounce inches of torque or less then 60 ounce inches of torque. It would have been obvious to one having ordinary skill in the art at the time the invention was made to required to separate the cover being 60 ounce inches of torque or less then 60 ounce inches of torque, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claims 2, 3, 14, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Netherton et al. (U.S. Patent 4, 900, 309). Netherton discloses a safety shield wing nut (as in figure 1-4) for attachment to a cover (18) with a bore (22), slots (28), wings (40) on collar (36), and housing (34).

Stevens discloses the claimed invention except for the wing nut. Netherton teaches that it is known to use a safety sheild wing nut as set forth in paragraphs at columns 2-4 to provide a safe means to separate and join the needle and cover while preventing needle sticks. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Stevens with safety wing nut as taught by Netherton, since such a modification would provide the

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system with a safety wing nut for providing a safe means to separate and join the needle and cover while preventing needle sticks.

Claims 9, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Newby et al. (U.S. Patent 6,436,086). Stevens discloses the claimed invention except for the attached rotatable collar and housing with hooks.

[*Reference B*] teaches that it is known to use an attached rotatable collar and housing with hooks as set forth in paragraphs at columns 4-6 to provide a safety cover after the device has been used and initial seal cover broken. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Stevens with attached rotatable collar and housing with hooks as taught by Newby since such a modification would provide the system with attached rotatable collar and housing with hooks for providing a safety cover after the device has been used and initial seal cover broken.

### ***Allowable Subject Matter***

Claims 15, 19, 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed 4/2/2010 have been fully considered but they are not persuasive. Applicant's argue that the finger grasp means of Stevens are not "at a desired location along the length of the cover". Examiner disagrees and draws applicant's attention to the finger grasp means (26 on cover 24) note there "desired position on the cover, As shown in figures 1-4.

The elements disclosed in the prior art of record are fully capable of satisfying all structural, functional, spatial, and operational limitations in the amended claims, as currently written, and the rejection is made and proper. See rejection discussion below.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gray whose telephone number is (571)272-7180. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Phillip Gray/  
Examiner, Art Unit 3767  
/Kevin C. Sirmons/  
Supervisory Patent Examiner, Art Unit 3767